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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,528	02/01/2001	Nicholas Donofrio JR.	248946.0005 (DONO-101.2)	2682

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Office Action Summary	Application No.	Applicant(s)
	09/775,528	DONOFRIO, NICHOLAS
	Examiner	Art Unit
	Naschica S Morrison	3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### **Status**

1) Responsive to communication(s) filed on 30 October 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### **Disposition of Claims**

4) Claim(s) 1-38 is/are pending in the application.

4a) Of the above claim(s) 2,5-10,18 and 21-32 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3,4,11-17,19,20 and 33-38 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 01 February 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### **Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### **Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

This is the second Office Action for serial number 09/775,528, Display Device for Sports Memorabilia, filed on February 1, 2001. Claims 1-38 are pending.

### *Election/Restrictions*

Claims 2,5-10,18, and 21-32 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.

### *Specification*

The disclosure is objected to because of the following informalities: on page 1, line 5, "is" should be --are-- and on line 18, "preferably" should be --preferable--; on page 5, line 1, "Teflon" should be --Teflon™--; on page 7, line 8 "132" should be --134--; on page 7, line 19, "152" should be --162--; on page 8, lines 10 and 14, "198" has been used to describe both "ball display device" and "arm assembly". Appropriate correction is required.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "arm assembly being rotatably secured to the base" and "the arms are secured to a support rotatably

mounted to the base" must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 14 objected to because of the following informalities: on line 6 insert --be-- after "cups can". Appropriate correction is required.

Claim 36 objected to because of the following informalities: on line 6 insert --be-- after "cups can". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17,19,20, and 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites the limitation "the sports memorabilia" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Double Patenting***

Applicant is advised that should claims 14-16 be found allowable, claims 36-38 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,3,4,11-17,19,20, and 33-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,199,804. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. 6,199,804 discloses all of the limitations of the claims except the first and second arms being rigid and including at least one flexible retainer such that the retainers may be spread apart to receive sports memorabilia therein. However, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to have modified the display device by providing rigid arms having flexible cups attached thereto as the means for receiving the sports memorabilia since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,4,14,17,19, 20, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,727,325 to Jurinic. Regarding claims 1,3,4,14,17,19, and 20, Jurinic discloses a display device comprising: a base (16); a rigid arm assembly (12) extending from the base and including first (18) and second (20) arms having spaced apart distal ends; and first and second flexible cups (32,34) attached to the first and second arms such that the cups face each other, wherein the flexible cups can be pressed against the arms to receive memorabilia therebetween and then released to hold the memorabilia.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11,12, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jurinic in view of U.S. Patent 2,572,454 to Down et al. (Down). With regards to claims 11,12, 33, and 34, Jurinic discloses the display device as applied above, but does not disclose the arm assembly being rotatably mounted to the base. Down discloses a display device comprising an arm assembly (34) secured to a support (32) rotatably mounted to a base (28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the display device by providing an arm assembly rotatably mounted to a base because one would have been motivated to provide a variable display that can be rotated at different angles as inherently taught by Down.

Claims 16 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jurinic in view of U.S. Patent 339,072 to Nies. With regards to claims 16 and 38, Jurinic does not disclose the arm assembly having a third arm. Nies discloses a clamp device (figure 1 generally) having a third arm (M) located between the first and second arms. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the arm assembly by including a third arm between the first and second arms (generally located at 14) because one would have been motivated to provide an additional arm to increase the attaching engagement of the arm assembly with the structure being clamped.

Claims 13,15,35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jurinic in view of U.S. Patent 5,560,579 to Woodside. With regards to claims 13,15,35, and 37, Jurinic discloses the display device as applied above, but does not disclose the base adapted to be hung on a wall. Woodside discloses a display device (Fig. 2) having a base (18) including apertures (29) for mounting to a wall. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the base by including apertures because one would have been motivated to permit the device to be mounted on vertical surfaces as well as horizontal surfaces as taught by Woodside (col. 3, lines 58-61).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

D335,400 to Reich; D365948 to Borden; 961319 to Scott; 2262873 to Wise; 2638347 to Colberg; 2665872 to De Witt; 3231993 to Levy; 3508732 to Trachtenberg et al; 3559935 to Gardner; 3601451 to Fauteux; 4848714 to Ziaylek, Jr. et al; 5082110 to Hager; 5165538 to Peters; 5377829 to Bahl; 5695056 to Bender et al; 5735075 to Honkawa et al; 5791075 to Martell; 5826837 to Moineau et al ; 5868249 to Ehnert ; 5881885 to Grimm; 5893553 to Pinkous; 5918393 to Martell; 5992811 to McFerren et al; 6016910 to Rodearmel; 6029826 to Clay

The above references disclose display devices/supports relevant to Applicant's invention. *Note: Copies of references cited in parent application 09/248,702 have not been provided unless relied upon in the rejections set forth above.*

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703)

305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 305-3598 (formal amendments) or (703) 308-3686 (informal amendment/communication).

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 308-2168.

  
Naschica S. Morrison  
Patent Examiner  
Art Unit 3632  
1/28/02

  
ANITA KING  
PRIMARY EXAMINER